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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/032,442	12/21/2001	Kenneth J. Muderlak	8026-1036	6103

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EXAMINER

KEASEL, ERIC S

ART UNIT	PAPER NUMBER
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3754

DATE MAILED: 12/05/2003

10

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/032,442

Applicant(s)

MUDERLAK, KENNETH J.

Examiner

Eric Keasel

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-40 is/are pending in the application.
- 4a) Of the above claim(s) 1-27 and 34-40 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 28-33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group I in Paper No. 9 is acknowledged. The traversal is on the ground(s) that applicant feels it would not be a burden on the examiner to search Group II (encompassing 6 species) with Group I claims. Applicant argues that claims 1-27 include a "flexible drive system", claims 34-40 include a "flexible drive mechanism", and claims 28-33 (i.e. Group I) include an "electromagnetic [sic] flexible actuator". Applicant goes on to argue that because Group I and Group II have claimed similar flexible properties, they would be efficiently searched together. This is not found persuasive because there is no basis to the perceived lack of burden.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1-27 and 34-40 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in Paper No. 9.

Information Disclosure Statement

3. The information disclosure statement filed 9 Sep 2002 fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the foreign references referred to therein have not been considered. Also, S/N 514224/97 is missing.

Specification

4. The specification is objected to as failing to provide clear support for the claim terminology. 37 CFR § 1.75(d)(1) requires that terms and phrases used in the claims find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description (see MPEP 608.01(o)). Specifically, the terms “attachment means for biasing the first and second bracket halves” (claim 30), “attachment means for securing the first and second bracket halves” (claim 31), and “means for biasing the first and second bracket halves” (claims 33) do not appear in the specification.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 28-33 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 30 recites “attachment means for biasing the first and second bracket halves”. Claim 31 recites “attachment means for securing the first and second bracket halves”. Claim 33 recites “means for biasing the first and second bracket halves”. None of these terms are used in the specification. The only disclosed elements that attach or secure the first and second bracket halves are the screws 84. However, the screws do not bias, so it is unclear what is meant by “attachment means for biasing the first and second bracket halves” in claim 30. Even if the

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screws are meant to be attachment means as well as biasing, claims 31 and 33 would be further indefinite because “attachment means for securing” and “means for biasing” are recited as two distinct elements.

In claim 28, line 4, “the electromechanical flexible enclosure” lacks clear antecedent basis. It is unclear whether this is meant to be the electromechanical flexible actuator or the enclosure.

In light of the above informalities, the claims have been examined as could best be understood by the examiner. The examiner's failure to apply prior art to any of the claims should not be construed as an indication of allowable subject matter.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

8. Claims 28-33 (as understood) are rejected under 35 U.S.C. 102(b) as being anticipated by Muderlak et al. (WO 97/13086).

The similarities between WO 97/13086 and the present application are remarkable. Please note that applicant's Figs. 10 and 11 appear to have been generated from Figs. 6 and 7 with a few modifications not relevant to claims 28-33. Claims 16-21 of WO 97/13086 are nearly identical to claims 28-33 of the present application. The actuator of Muderlak et al. is considered to anticipate the broadest reasonable interpretation of “flexible” actuator.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claims 28-33 (as understood) are rejected under 35 U.S.C. 103(a) as being unpatentable over Muderlak et al. (WO 97/13086) in view of Bush (US Patent Number 3,680,406).

If a narrower interpretation of "flexible actuator" is used to include a flexible cam, then Muderlak et al. do not disclose the flexible cam. Bush discloses a flexible cam. It would have been obvious to one having ordinary skill in the art at the time the invention was made to have used the flexible cam of Bush with the apparatus of Muderlak et al. in order to have a means for correcting the contour of the cam without the labor of reshaping or discarding the original cam as taught by Bush (see abstract, lines 1-3).

Conclusion

11. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Chiang et al. disclose a similar detachable actuator for a flush valve. Adam and Tarello disclose flexible cams.

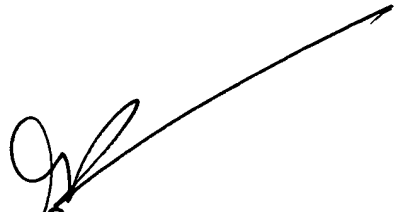
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Keasel whose telephone number is (703) 308-6260. The examiner can normally be reached on Monday-Thursday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Gene Mancene can be reached on (703) 308-2696. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0861.

ek
26 Nov 2003



Gene Mancene
Supervisory Patent Examiner
Group 3700